

REMARKS**Status of the Claims**

Upon entry of the amendment above, claims 14-48 will be pending, claims 14, 15, 29, 30, and 44 being independent.

Summary of the Office Action

Claims 14-18, 20-22, 25, 26, 28-30, 35-42, and 44-47 are rejected under 35 USC §102(b) as being anticipated by ELLIS et al. (U.S. Patent No. 3,206,874, hereinafter "ELLIS").

Claims 14-18, 20-22, 25, 26, 28-30, 35-42, and 44-47 are rejected under 35 USC §102(b) as being anticipated by O'DONNELL (U.S. Patent No. 3,068,593).

Claims 27, 43, and 48 are rejected under 35 USC §103(a) as being unpatentable over ELLIS.

Claims 19 and 31-34 are rejected under 35 USC §103(a) as being unpatentable over ELLIS in view of French Patent Publication No. 2 361 837 (hereinafter "LANDRY").

Claims 19 and 31-34 are rejected under 35 USC §103(a) as being unpatentable over O'DONNELL in view of French Patent Publication No. 2 361 837 (hereinafter "LANDRY").

Claims 23 and 24 are identified as containing allowable subject matter, but are objected to for depending from rejected claims.

Response to the Office Action**A. Withdrawal of Rejections Based Upon ELLIS or O'DONNELL**

Applicant respectfully requests that the rejections under 35 USC §102(b) and §103(a), based upon ELLIS and O'DONNELL, alone or in combination with LANDRY, be withdrawn.

Although Applicant has read the Examiner's comments in support of her rejections in the final Office action, he nevertheless submits that the rejections are erroneous for reasons previously presented.

Herein, Applicant kindly requests that the Examiner reconsider at least the following points, which are not believed to have been fairly addressed in the final rejections.

1. The Covers of the Shoes of ELLIS and O'DONNELL Do *Not* Cover the Flexion Fold Zone

In the final rejection, the Examiner maintains her rejections based upon ELLIS and O'DONNELL. In the sentence that bridges pages 5 and 6 of the Office action, the Examiner claims "the device of Ellis '874 and O'Donnell '593 do indeed cove [*sic*, cover] the flexion fold zone of their shoe."

As Applicant has explained in his previous reply, this description of the shoes of ELLIS and O'DONNELL is not correct.

Further, even if the Examiner's subsequent statement on page 6 of the Office action were true, viz., "[t]he location of the flexion fold zone is dependent on the type and size of the shoe and will vary from one type of shoe to another", the statement is irrelevant regarding ELLIS and O'DONNELL in view of the express teachings of both ELLIS and O'DONNELL.

That is, both ELLIS and O'DONNELL explain why the guard flap 36 (of ELLIS) and the protector flap 32 (of O'DONNELL) do *not* extend to the flexion fold zone. For example, in the two paragraphs appearing in column 1, lines 29-37, and column 3, line 71, to column 4, line 4, ELLIS explains that his "guard flap ... will not interfere with the free flexing of the foot and shoe while walking" Similarly, see column 1, lines 30-31 of O'DONNELL: "... the protector is relatively light and compact and will not interfere with the flexing of the shoe"

If the Examiner's position were correct, *i.e.*, that the covers of ELLIS and O'DONNELL (guard flap 36 and protector flap 32, respectively) ^{*extend*} cover a flexion fold zone, *then the covers of ELLIS and O'DONNELL would interfere with the flexing of the shoe.*

At least in view of the foregoing, reconsideration and withdrawal of the rejections based upon ELLIS and O'DONNELL are requested.

2. The Examiner's Position is Contrary to the Express Teachings of ELLIS and O'DONNELL

extends
If the Examiner were not to allow the instant application at this time but to maintain her rejection, Applicant kindly requests, so that he can properly present her position on appeal, if the instant application were to then go to appeal, an explanation is requested as to how the explicitly described flexing property of the shoes of ELLIS and O'DONNELL can be maintained if the covers (guard flap 36 of ELLIS and protector flap 32 of O'DONNELL), which are made of steel or other rigid material (see column 3, lines 2-6 of ELLIS and column 2, lines 54-56 of O'DONNELL), do in fact cover the flexion zone of their respective shoes.

3. LANDRY's Teaching is Inapplicable/Contrary to the Teachings of ELLIS and O'DONNELL

Applicant requests that the rejections of claims 19 and 31-34 over ELLIS and LANDRY and over O'DONNELL and LANDRY be withdrawn.

In each rejection, the Examiner has taken the position that "it would have been an obvious matter of design choice to modify the shape and size of the device since such a modification would have involved a mere change in the size and shape of a component."

Again, this is not true.

That is, in addition to changing the size and shape of the cover of both ELLIS and O'DONNELL in meeting the terms of the rejected claims, the proposed modification of ELLIS and O'DONNELL by means of the teachings of LANDRY would be a change that would be contrary to the express teachings of ELLIS and LANDRY.

A primary objective of LANDRY is to provide a relatively soft boot with sufficient stiffness so that the boot may be used for alpine skiing or the like (see page 1, lines 15-20 of LANDRY). That is why LANDRY discloses a cover that surrounds the boot at least in the instep area and in the front of the ankle area (see page 1, lines 38-40 of LANDRY).

Of course, ELLIS and O'DONNELL do *not* want to provide their flexible shoes with rigidity for alpine skiing or otherwise. Instead, as Applicant has explained above, although ELLIS and O'DONNELL wish to protect the front of their shoes, *neither ELLIS nor O'DONNELL want to interfere with the flexing of their shoes*. Thus, the objective of LANDRY is directly contrary to that of ELLIS and O'DONNELL. As explained in *In re Gordon*, 221 USPQ 1125 (Fed. Cir. 1984), a proposed modification is inappropriate as a consideration regarding obviousness under 35 USC §103 when such modification would have rendered the prior art reference inoperable for its intended purpose.

B. Amendment of Claim 30

Applicant respectfully requests entry of the amendment to claim 30, which has been placed into independent form above, and the allowance thereof.

Claim 30, as amended, includes the subject matter of claim 29, and it describes the cover with more deliberateness. More specifically, the cover is described as being comprised of three parts, *viz.*, an *intermediate* part, an *upper* part, and a *lower* part.

Applicant has described the cover in this manner for the purpose of emphasizing that the shape of the cover of the invention, such as, *e.g.*, the shape shown in the illustrated embodiment, encompasses quite a different construction compared to that of either ELLIS or O'DONNELL. For example, Applicant's cover has a lower part that extends in a direction substantially in the direction of the bottom of the sole (substantially horizontal) and an upper part that extends in a direction substantially along the lower leg (substantially vertical). Between the two parts is an intermediate part that represents a bend, *i.e.*, a transition in the direction in

which the cover extends. This is significantly different from the shapes of the covers of ELLIS and O'DONNELL, which shape extends essentially along a single direction from the toe to the instep.

With reference to Fig. 2 of both ELLIS and O'DONNELL, both ELLIS and O'DONNELL teach that the cover cannot extend upwardly beyond the point shown, inasmuch as flexion of the shoe/foot is to be preserved. This point in ELLIS and O'DONNELL approximately corresponds to the point that Applicant's lowermost instep strap 13 is positioned, shown in Applicant's Fig. 5. Therefore, the covers of ELLIS and O'DONNELL cannot extend upwardly to be positioned in front of the lower leg as can Applicant's cover. Such a cover would be contrary to the express teachings of ELLIS and O'DONNELL.

Now, with regard to the language of claim 30, the first 13 lines describe various zones of the upper of the article of footwear. Included therein is mention of an upper front zone and an upper rear zone, both of which extend in an upward direction so that they are adapted to be positioned forwardly and rearwardly, respectively, of the lower leg of the wearer.

Beginning with line 14 of claim 30, Applicant calls for the cover to have three parts, viz., an upper part, an intermediate part, and a lower part, the intermediate part of the cover covering the flexion fold zone of the article of footwear, the lower part extending forwardly from the intermediate part of the cover along an area above the front end zone of the article of footwear, and the upper part extending upwardly from the intermediate part along an area in front of the upper front zone of the upper of the article of footwear, whereby the upper part of the cover extends substantially in the aforementioned upward direction of the front and rear zones of the upper of the article of footwear.

Although Applicant has presented an amendment to claim 30 in this reply after the final Office action, Applicant kindly requests that the amendment be entered. No additional claims have been presented herein and Applicant submits that no additional search would be necessitated by the amendment to claim 30. Indeed, Applicant submits that in identifying the LANDRY patent, the Examiner would likely have searched for the subject matter of claim 30, as amended herein.

C. Request for Examiner's Consideration

If, after reconsidering her positions, the Examiner were to be of the opinion that she would prefer different wording in any of the independent claims for allowance, or if she were to be aware of an amendment that she might believe that Applicant would consider in reaching allowance, she is kindly requested to contact Applicant's undersigned representative to discuss any such revision/amendment.

SUMMARY AND CONCLUSION

Entry of the amendment is requested, together with reconsideration and withdrawal of the rejections.

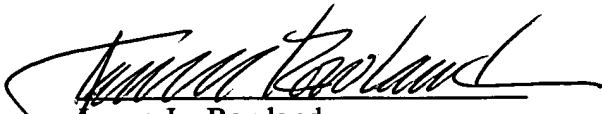
A check is enclosed for payment of a claim fee. No additional fee is believed to be due at this time. However, the Commissioner is authorized to charge any fee required for acceptance of this reply as timely and complete to Deposit Account No. 19-0089.

Further, although no extension of time is believed to be necessary at this time, if it were to be found that an extension of time were necessary to render this reply timely and/or complete, Applicant requests an extension of time under 37 CFR §1.136(a) in the necessary increment(s) of month(s) that would render this reply timely and/or complete and the Commissioner is

authorized to charge any necessary extension of time fee under 37 CFR §1.17 to Deposit Account No. 19-0089.

Any comments or questions concerning this application can be directed to the undersigned at the telephone or fax number given below.

Respectfully submitted,
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